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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,086	06/16/2000	Elfi Biedermann	69054	3172

22242 7590 05/11/2006

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CHICAGO, IL 60603-3406

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,086

Applicant(s)

BIEDERMANN ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-77 is/are pending in the application.
- 4a) Of the above claim(s) 73-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 55-77 are pending in the application.

Election/Restrictions

1. Applicant's election with traverse of the species of compound 120, i.e. N-(6,6-di(phenyl)-hex-5-enyl)-3-pyridin-3-yl-acrylamide in the reply filed on February 23, 2006 is acknowledged. The traversal is on the ground(s) that all compounds described in the present application share a common core structure. This is not found persuasive because the compounds, compositions and method of use of the compounds of formula (I) of the instant invention embrace a wide variety of compounds with respect to A, D and G.

Note MPEP 2173.05(h) "where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression. Therefore, what should be considered for patentable distinctness is the compound as a whole. Would a whole compound where the compound is a phosphonyl compound be patentably distinct from a whole compound where the compound is a sulfonamide? If a reference for one would not be a reference for the other, then restriction is considered proper. It is the compound as a whole that must be considered for patentable distinctness.

Thus, separate searches in the literature would be required. However, should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Additionally, the applicants stated that the claimed compounds of formula (I) share a common core. A special technical feature is that portion of the formula, which makes a contribution over the prior art, the compound N-[5-[4-(diphenylmethyl)-1-piperazinyl]pentyl]-3-(6-methyl-3-pyridinyl)-2-propenamide possesses the pyridine-3-yl-acrylamide core and thus pyridine-3-yl is not sufficient of a special technical feature.

The requirement is still deemed proper and is therefore made FINAL.

2. The compounds, compositions and method of use of the compounds of formula (I) of the instant invention have been searched to the extent that A is -CH=CH-; and G is G¹ or G².

3. Claims 73-77 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 23, 2006.

Information Disclosure Statement

4. With regards to the objection to the Information Disclosure Statement the applicants stated in their response filed August 26, 2004 that a Supplemental IDS that

addresses the objections raised by the Examiner is submitted herewith. However, as stated in the last office action a Supplemental IDS still has not been received.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 57 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The definition of the substituents on the aromatic ring systems of R¹, R⁸, R⁹, R¹⁰, R¹¹, R¹², Ar¹ and Ar² and =CR⁸R⁹ where the substituent is for two adjacent residues on the aromatic ring is not defined in the specification with respect to the genus when it is anything other than methylenedioxy.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

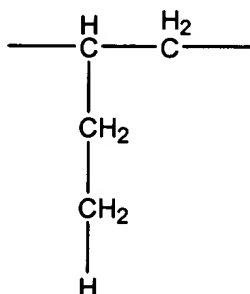
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

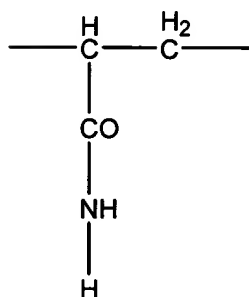
6. Claims 55-57, 60, 72 and claims dependent thereon are rejected under 35 U.S.C. 102(a and e) as being anticipated by Hayes et al., WO 98/34111 (U.S. equivalent 5,925,527). In view of the applicant's election of the compound 120 and the expansion of the search where A is $-\text{CH}=\text{CH}-$ and G is G^1 the following rejection is maintained. The 35 U.S.C. § 102, anticipation rejection labeled paragraph 21 of the last office action, the applicants stated that Hayes et al. cannot anticipate the compounds and compositions of the present invention because D cannot represent $-\text{CH}(\text{CONH}_2)-\text{CH}_2-$. The definition of D is such that D is selected from the group consisting of C_3-C_{12} -alkylene and C_3-C_{12} -alkylene, wherein, with the exception of the (G)-terminal methylene group in the C_3-C_{12} -alkylene, one to three methylene units in the C_3-C_{12} -alkylene are isosterically replaced by O, S, NR^7 , CO, SO or SO_2 , wherein R^7 is selected from the group consisting of hydrogen, C_1-C_6 -alkyl, C_1-C_6 -alkenyl, C_1-C_6 -acyl, and C_1-C_6 -alkanesulfonyl. The applicants stated that a methyl group does not contain a methylene unit and an isosteric replacement of a methylene unit in a CH_3 group is not possible and one cannot end up at aminocarbonayl-ethylene for the definition of D. D can be as follows:

a. D is C_4 -alkylene, i.e.



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- b. With the exception of the (G)-terminal methylene group in the C₄-alkylene, one to three methylene units in the C₄-alkylene are isosterically replaced by NH and CO, i.e.



- d. The end product as taught by Hayes, i.e. $\text{---CH(CONH}_2\text{)---CH}_2\text{---}$.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 55-71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-20 of U.S. Patent No. 6,506,572. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the compounds of formula (I) are embraced by the compounds of U.S. '572 where Z is N.

Conclusion

8. Applicants' attention is directed to U.S. Patent No. 6,313,153, which while not competent as a reference against the instant claims, claims subject matter that is similar and/or identical to that claimed herein. Two patents cannot issue on the same subject matter, unless applicants can demonstrate that the claims are patentably distinct from the claims of this US patent, the only way to overcome this patent is by way of Interference proceedings or removal of the conflicting subject matter. See MPEP 2306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Brenda Coleman". The signature is fluid and cursive, with a long horizontal flourish extending to the right.

Brenda L. Coleman
Primary Examiner Art Unit 1624
May 9, 2006